

Application Serial No. 09/810,559
Attorney Docket No. 110275.4500-US2

PATENT

REMARKS

The applicants would like to thank the Examiner for withdrawing his objections to the drawings.

I. Status of claims

In the Office Action, the Examiner noted that claims 66-130 are pending in the application, and that claims 66-130 are rejected.

By this Amendment, claims 66, 91, and 108 have been amended, and claims 88 and 89 have been cancelled. Accordingly, claims 66-87 and 90-130 are pending in the application.

II. Claim objections

Claims 88 and 89 are objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Accordingly applicants have canceled claims 88 and 89, and therefore respectfully request the Examiner to withdraw this objection.

III. Applicants admitted prior art

Applicants concede that Figures 1-3 labeled "prior art", and the corresponding description are prior art. However, the corresponding description ends after the first full paragraph on page 13 of the specification, and the description following that paragraph is not prior art.

As stated in MPEP § 2129(II),

"Where the specification identifies work done by another as "prior art," the subject matter so identified is treated as admitted prior art. In re Nomiya, 509 F.2d 566, 571, 184 USPQ 607, 611 (CCPA 1975) (holding applicant's labeling of two figures in the application drawings as "prior art" to be an admission that what was pictured was prior art relative to applicant's improvement)."

No statement labeling description following the description that corresponds to Figures 1-3 was labeled as prior art. Therefore applicants respectfully request the Examiner to provide

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prior art teachings of those parts of the specification after the description corresponding to Figures 1-3 relied on as support for the Examiner's arguments.

IV. Claim rejections

A. Rejection of claims 66-74, 76-88, 90-127, 129, and 130 under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claims 66-74, 76-88, 90-127, 129, and 130 under 35 U.S.C. § 103(a) as being unpatentable over Applicants' admitted prior art (AAPA), in view of U.S.P.N 6,336,171 issued to Coskrey, IV ("Coskrey"). This rejection is respectfully traversed.

1. Claims 66, 91, and 108 have been amended

First, claims 66, 91 and 108, have been amended to more clearly point out the features of the first and second wireless communication devices in the present system. The system comprises "processing means for sending and receiving of messages in real time . . . and for processing messages to the at least one of the first and second wireless communications devices from within both the first and second data message accounts." Processing means for processing messages sent to the first and second wireless communication devices from within both a first and second data message account is now clearly recited. In addition, one of these accounts is a POP or IMAP account.

Coskrey teachings are limited to servers that provide gateway services, and the AAPA does not make up for the deficiencies of Coskrey, because it does not teach processing means for processing messages from within both a first a second data message account. For example, as stated on page 13 of the specification, "Prior art FIGs. 1-3, however, do not generally relate to, for example, providing an integrated or combination real time and polled electronic messaging system." Therefore, even if, as the Examiner argues, the AAPA can be combined with Coskrey, the combination would not teach all the limitations of claims 66, 91, and 108. Therefore, the Examiner is respectfully requested to withdraw this rejection.

2. There is no motivation to modify the teachings of the AAPA using Coskrey

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Second, even if Coskrey taught gateways “operatively connectable to each other,” there is no motivation to modify the AAPA based on Coskrey to provide real-time or polled transmission by the gateways. The Examiner stated that one of ordinary skill in the art would be motivated to do this because,

“Having the first and second gateways operatively connectable to each other to perform real time and polled transmission would efficiently provide both these highly desirable services to a user.” (Office action, page 7).

The Examiner’s motivation does not provide sufficient support for combining the references. See MPEP § 2144. The Examiner provides no support as to why having the first and second gateway operatively connectable to each other to perform real time and polled transmission would be more efficient than having the gateways individually provide the services. In fact, the stated motivation is similar to the one stated in applicant’s specification for development of the invention, “we have also determined that a need exists for an **integrated** wireless communication system” (emphasis added).

Further, the Examiner argued that ,

“it would have been obvious to one of ordinary skill in the art to modify the teachings of the AAPA to have the first and second gateways connected to each other . . . to provide such services more efficiently.” (Office action, page 3)

As argued above, this motivation does not provide sufficient support for modifying the AAPA.

3. Rejection of claims 67, 92, and 109

Regarding claims 67, 92, and 109, the portion of the specification cited as prior art by the Examiner states on page 14 only that “users can access their Internet . . . by . . . setting one or more times at which the wish to receive their messages.” Therefore the AAPA fails to teach, at least, a device action manager, a download manager, a message lookup manager, and a message processor.

Further because claims 67, 92, and 109, depend from claims 66, 91, and 108 respectively, and because the AAPA and Coskrey do not teach all the limitations of claims 66, 91, and 108, claims 67, 92, and 109 are patentably distinguishable from the cited prior art.

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4. Rejection of claims 68 and 93

Regarding claims 68 and 93, page 14 of the specification cited as prior art by the Examiner fails to teach, at least, the accessing of subscriber information by the scheduler.

Further because claim 68 and 93 depend from claims 66 and 91, and because the AAPA and Coskrey do not teach all the limitations of claims 66 and 91, claims 68 and 93 are patentably distinguishable from the cited prior art.

5. Rejection of claims 70 and 95

Regarding claims 70 and 95, page 14 of the specification cited as prior art by the Examiner fails to teach, at least, downloading messages subsequent to receiving an indication from the scheduler.

Further because claims 70 and 95 depend from claims 66 and 91, and because the AAPA and Coskrey do not teach all the limitations of claims 66 and 91, claims 70 and 95, are patentably distinguishable from the cited prior art.

6. Rejection of claims 71, 96, and 129

Regarding claims 71, 96, and 129, the Examiner stated that it was implicit in the teaching of the AAPA that the message processor converts the message format. Assuming, without agreeing that conversion of the message format is inherent, this argument is directed towards anticipation not obviousness. As stated by the Federal Circuit in *MEHL/Biophile Int'l Corp. v. Milgraum*, "Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art." 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305-06 (Fed. Cir. 1999). Although the conversion of the message may be inherent, the examiner has not provided a teaching that the inherent feature would have been recognized by one of ordinary skill in the art, as necessary to establish a prima facie case of obviousness. Therefore the AAPA does not teach the feature of a message processor converting the message format of the third communication device to a message format of the at least one first wireless communication device. Accordingly, applicants respectfully request the withdrawal of the rejection of claim 71, 96, and 129.

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7. Rejection of claims 72, 97, and 130

Regarding claims 72, 97, and 130 the Examiner stated that is was implicit in the AAPA that the lookup manager deletes a message record when a corresponding message is deleted. As argued above, even if this teaching was inherent, that examiner has not provided a teaching that he inherent feature would have been recognized by one of ordinary skill in the art, as necessary to establish a prima facie case of obviousness. Therefore the AAPA does not teach the feature of lookup manager deleting a message when corresponding message are deleting on the at least one third communication device. Applicants respectfully request the Examiner to withdraw the rejection of claims 72, 97, and 130.

8. Rejection of claim 73

Regarding claim 73, pages 14-15 of the specification cited as prior art by the Examiner fails to teach, at least, gateways having a common domain name associated therewith.

Further because claim 73 depends from claim 66, and because the AAPA and Coskrey do not teach all the limitations of claims 66, claim 66 is patentably distinguishable from the cited prior art.

9. Rejection of claims 74, 88, and 127

Regarding claims 74 and 127, pages 14-15 of the specification cited as prior art by the Examiner fail to teach a gateway transmitting signals on a real time basis with the at least one first and second wireless communication devices.

Further because claims 74 and 127 depend from claims 66 and 108 respectively, and because the AAPA and Coskrey do not teach all the limitations of claims 66 and 108, claims 74 and 127 are patentably distinguishable from the cited prior art. Claim 88 has been cancelled by this amendment.

10. Rejection of claims 76 and 90

Regarding claims 76 and 90, pages 14-15 of the specification cited as prior art by the Examiner fail to teach, at least, a fax being transmitted in real time by the first and second gateway.

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Further because claims 76 and 90 depend from claim 66, and because the AAPA and Coskrey do not teach all the limitations of claim 66, claims 76 and 90 are patentably distinguishable from the cited prior art.

11. Rejection of claims 77 and 98

Regarding claims 77 and 98, pages 15-16 of the specification cited as prior art by the Examiner fail to teach, at least, that the predetermined criteria of claims 66 and 91 as an Internet domain.

Further, because claims 77 and 98 depend from claim 66 and 91, and because the AAPA and Coskrey do not teach all the limitations of claims 66 and 91, claims 77 and 98 are patentably distinguishable from the cited prior art.

12. Rejection of claims 78, 99, and 115

Regarding claims 78, 99, and 115, pages 15-16 of the specification cited as prior art by the Examiner fail to teach, at least, that the Internet domain name is the name of an organization or of an individual, combined with a top level domain name.

Further, because claims 78, 99, and 115 depend from claims 66, 91, and 108, and because the AAPA and Coskrey do not teach all the limitations of claim 66, 91, and 108, claims 76 and 90 are patentably distinguishable from the cited prior art.

13. Rejection of claims 79, 100, and 116

Regarding claims 79, 100, and 116, pages 15-16 of the specification cited as prior art by the Examiner fail to teach, at least, the specific top level domain names recited in the claims.

Further, because claims 79, 100, and 116, depend from claim 66, 91, and 108, and because the AAPA and Coskrey do not teach all the limitations of claim 66, 91, and 108, claims 79, 100, and 116 are patentably distinguishable from the cited prior art.

14. Rejection of claims 80, 101, and 121

Regarding claims 80, 101, 121, pages 7-10 of the specification cited by the Examiner fail to teach, at least, the predetermined criteria comprising an identifier.

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Further, because claims 80, 101, and 121 depend from claims 66, 91, and 108, and because the AAPA and Coskrey do not teach all the limitations of claim 66, 91, and 108 claims 80, 101, and 121 are patentably distinguishable from the cited prior art.

15. Rejection of claims 81, 102, and 117

Regarding claims 81, 102, and 117, because claims 81, 102, and 117 depend from claims 66, 91, and 108, and because the AAPA and Coskrey do not teach all the limitations of claim 66, 91, and 108 claims 81, 102, and 117 are patentably distinguishable from the cited prior art.

16. Rejection of claims 82 and 122

Regarding claims 82 and 122, pages 7-10 of the specification cited by the Examiner fail to teach, at least, a third communication device that is an email server storing messages and having a second identifier.

Further, because claims 82 and 122 depend from claims 66 and 108, and because the AAPA and Coskrey do not teach all the limitations of claim 66 and 108 claims 82 and 122 are patentably distinguishable from the cited prior art.

17. Rejection of claims 83, 103, 119, and 123

Regarding claims 83, 103, 119, and 123, because they depend from claims 66, 91, and 108, and because the AAPA and Coskrey do not teach all the limitations of claim 66, 91, and 108, claims 83, 103, 119, and 123, are patentably distinguishable from the cited prior art.

18. Rejection of claims 84, 104, 120, and 124

Regarding claims 84, 104, 120, and 124, because they depend from claims 66, 91, and 108, and because the AAPA and Coskrey do not teach all the limitations of claim 66, 91, and 108, claims 84, 104, 120, and 124, are patentably distinguishable from the cited prior art.

19. Rejection of claims 85, 105, and 125

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Regarding claims 85, 105, and 125, pages 13-14 of the specification cited as prior art by the Examiner fails to teach, at least, allowing a user to select between real-time and polled transmission.

Further, because claims 85, 105, and 125 depend from claims 66, 91, and 108, and because the AAPA and Coskrey do not teach all the limitations of claim 66, 91, and 108, claims 85, 105, and 125, are patentably distinguishable from the cited prior art.

20. Rejection of claims 86 and 106

Regarding claims 86 and 106, pages 14-15 of the specification cited as prior art by the Examiner fails to teach allowing a user to select a name of a specified email account.

Further, because claims 86, 106, depend from claims 66 and 91, and because the AAPA and Coskrey do not teach all the limitations of claim 66 and 91, claims 86 and 106, are patentably distinguishable from the cited prior art.

21. Rejection of claims 87, 107, and 126

Regarding claims 87, 107, and 126, pages 14-15 of the specification cited as prior art by the Examiner fails to teach, at least, providing a means by which the user can specify the time at which an email message is downloaded.

Further, because claims 87, 107, and 126 depend from claims 66, 91, and 108, and because the AAPA and Coskrey do not teach all the limitations of claim 66, 91, and 108, claims 87, 107, and 126, are patentably distinguishable from the cited prior art.

22. Rejection of claim 110

Regarding claim 110, pages 13-15 of the specification cited as prior art by the Examiner fail to teach a the at least one second gateway monitoring which of the at least one first wireless communication device has requested to download a message.

Further because claim 110 depends from claim 108, and because the AAPA and Coskrey do not teach all the limitations of claim 108, claim 110 is patentably distinguishable from the cited prior art.

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23. Rejection of claim 111

Regarding claim 111, pages 13-15 of the specification cited as prior art by the Examiner fail to teach a the at least one second gateway monitoring when messages associated with the first wireless communications device are to be downloaded.

Further, because claim 111 depends from claim 108, and because the AAPA and Coskrey do not teach all the limitations of claim 108, claim 111 is patentably distinguishable from the cited prior art.

24. Rejection of claim 112

Regarding claim 112, pages 13-15 of the specification cited as prior art by the Examiner fail to teach, at least, where the at least one second gateway recognizes an identifier, and selects only those messages that have not been downloaded.

Further, because claim 112 depends from claim 108, and because the AAPA and Coskrey do not teach all the limitations of claim 108, claim 112 is patentably distinguishable from the cited prior art.

25. Rejection of claim 113

Regarding claim 113, pages 13-15 of the specification cited as prior art by the Examiner fail to teach, at least, where the at least one second gateway retrieves messages not yet downloaded. .

Further, because claim 113 depends from claim 108, and because the AAPA and Coskrey do not teach all the limitations of claim 108, claim 113 is patentably distinguishable from the cited prior art.

26. Rejection of claim 114

Regarding claim 114, pages 7-10 and 13-15 of the specification cited as prior art by the Examiner fail to teach either option for further limiting predefined criteria.

Further, because claim 114 depends from claim 108, and because the AAPA and Coskrey do not teach all the limitations of claim 108, claim 114 is patentably distinguishable from the cited prior art.

27. Rejection of claim 118

Regarding claim 118, because claim 118 depends from claim 108, and because the AAPA and Coskrey do not teach all the limitations of claim 108, claim 110 is patentably distinguishable from the cited prior art.

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Accordingly, since neither Coskrey nor the AAPA, taken alone or in combination, teaches or suggests the claims elements, claims 66-74, 76-88, 90-127, 129, and 130, are patentably distinguishable over the prior art. The Examiner is respectfully requested to withdraw this rejection.

B. Rejection of claims 75, 89, 128 under 35 U.S.C. § 103(a)

The Examiner rejected claims 75, 89, and 128 under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admitted prior art (AAPA), in view of Coskrey and in further view of U.S.P.N. 5,951,694 issued to Choquier et al. ("Choquier"). This rejection is respectfully traversed.

Claims 75 and 89 depend from claim 66, and claim 128 depends from claim 108, because Coskrey does not make up for the deficiencies of the AAPA in teaching all the claims limitations, as described above, claims 75, 89, and 128 are patentably distinguishable from the cited prior art. The examiner is respectfully requested to withdraw this rejection.

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CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or explicitly recite that which is already present within the claims. Moreover, Applicants reserve the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

Any claims that have been cancelled are hereby cancelled without prejudice or disclaimer, and Applicants reserve the right to further prosecute these claims in continuing applications. In addition, Applicants have attempted to claim all embodiments disclosed in the present application, and no disclaimer of any embodiments is hereby intended by the presently pending claims.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present

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claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents and/or statutory equivalents, i.e., all equivalents that are substantially the same as the presently claimed invention.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintain the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

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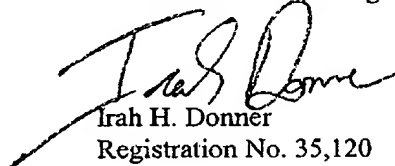
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

Wilmer Cutler Pickering Hale and Dorr LLP


Ira H. Donner
Registration No. 35,120

399 Park Avenue
New York, NY 10022
TEL (212) 230-8887
FAX (212) 230-8888

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